



# UNITED STATES PATENT AND TRADEMARK OFFICE

94  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,250	08/01/2003	Christopher M. Pirich	MSI-1692US	3300
22801	7590	10/10/2006	EXAMINER	
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201				RUSSELL, TRACI L
ART UNIT		PAPER NUMBER		
		2136		

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/632,250	PIRICH ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Traci L. Russell	2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08/01/2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed..
- 6) Claim(s) 1-36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 08/01/2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/04/2004</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Pursuant to U.S.C. 131, claims 1-36 have been examined.

### ***Claim Objections***

1. Claim 29 objected to because of the following informalities: The claim limitation discloses a computer readable memory having computer readable instructions that when executed by a processor. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
3. Claims 20, 29, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each claim limitation discloses ‘attempting to’ which is vague and indefinite language. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1 - 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Claims 1, 10, 11, and 14 disclose an apparatus comprising media including game content and a data protection, media type checking portion, and alteration checking portion.

It appears that the claims are directed towards a functional descriptive, *per se*, which does not produce a useful, concrete and tangible result. The indicating step is conditional and the result has not been utilized nor made available in such a manner that any usefulness of having performed the validation can be realized. Appropriate amendment to the claim is required to continue the process until there is a tangible result.

4. Claim 36 disclose a computer readable memory having instructions, which fail to produce a useful, concrete, and tangible result. Appropriate amendment to the claim is required.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

*Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 4, 6 – 30, and 36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 26 of copending Application No. 10/632,887. Although some of the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention is an obvious variation of the claimed invention in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending

application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP.

§ 804.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as shown in the table below:

<b>Instant Application: 10/632,250</b> <b>Claim 1</b>	<b>Co-pending Application: 10/632,887</b> <b>Claim 1</b>
An apparatus comprising:	An apparatus comprising:
1(a) a media including game content; and	1(a) a media including game content; and
1(b) a data protection portion that includes a file alteration checking portion, the file alteration portion protects the media from modification of the game content by determining whether the game content has been modified, and if the game content has been modified, then the installation of the game content within the apparatus fails.	1(b) a data protection portion including a file system alteration checking portion that protects the apparatus from modification of the game content by determining whether the game content has been modified, and if the game content has been modified, the use of the game content within the apparatus fails.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-36 are rejected under 35 U.S.C. 102(e) as being unpatentable by Whitten, et al (US 2003/0182574).

with regard to claim 1:

Whitten, et al discloses an apparatus as required in claim 1 comprising: a media including game content; and a data protection portion that includes a file alteration checking portion, the file alteration checking portion protects the media from modification of the game content by determining whether the game content has been modified, and if the game content has been modified, then the installation of the game content within the apparatus fails ['computing device'; Page 2, paragraphs 9, 11].

with regard to claim 2:

Whitten, et al discloses the apparatus as required of claim 1, wherein the game content includes music that can be played on the game console ['gaming system is capable of playing games, music, and videos'; Page 3, paragraphs 32-35].

with regard to claim 3:

Whitten, et al discloses the apparatus as required of claim 1, wherein the game content includes audio that can be played on the game console ['digital audio visual'; Page 4, paragraph 35].

with regard to claim 4:

Whitten, et al discloses the apparatus as required of claim 1, wherein the game content includes non-game related material that can be played on the game console ['game titles, digital music, digital audio visual'; Page 3, paragraphs 32-35].

with regard to claim 5:

Whitten, et al discloses the apparatus as required of claim 1, wherein the game content includes game related material that can be played on the game console ['game programs are preferable distributed for use with the game console'; Fig 1; Page 3, paragraph 27].

with regard to claim 6:

Whitten, et al discloses the apparatus as required of claim 1, wherein the media includes a removable media that is removable from the apparatus ['portable optical storage media'; Fig 1; Page 3, paragraph 27].

with regard to claim 7:

Whitten, et al discloses the apparatus as required of claim 1, wherein the media includes a removable media that is removable from the apparatus, and wherein the removable media includes an optical disk ['optical storage disk, 108' in Fig 1; Page 1, paragraph 27].

with regard to claim 8:

Whitten, et al discloses the apparatus as required of claim 1, wherein the media includes a removable media that is removable from the apparatus, wherein the removable media includes a digital video disk ['digital versatile disks'; Page 1, paragraph 7; 'DVD'; Page 3, paragraph 27].

with regard to claim 9:

Whitten, et al discloses the apparatus as required of claim 1, wherein the apparatus includes a game console ['game console, 108' in Fig 1; Page 3, paragraph 27].

with regard to claim 10:

Whitten, et al discloses the apparatus as required of claim 1, wherein the data protection portion includes a media type checking portion for checking whether the type of the media is as expected for media that has not been copied ['logic used to secure the game software', 'certificate specifies type of media'; Fig 4, Page 5, paragraph 51].

with regard to claim 11:

Whitten, et al discloses the apparatus as required of claim 1, wherein the data protection portion includes a media type checking portion for checking whether the type of the media is as

expected for media that has not been copied, and wherein the media type checking portion reduces the possibility of copying the game content from a pressed disk to an end user writable disk ['certificate specifies type of media'; Page 5, paragraph 51].

with regard to claim 12:

Whitten, et al discloses the apparatus as required of claim 1, wherein the data protection portion checks the entire file to ensure that the media has not been invalidated ['authenticating the software data'; Page 6, paragraphs 57-59].

with regard to claim 13:

Whitten, et al discloses the apparatus as required of claim 1, wherein the data protection portion includes a file signature checking portion for checking whether the file signature is as expected for media that has not been modified ['game console can detect altered software'; Page 6, paragraph 60; Page 7, paragraph 64].

with regard to claim 14:

Whitten, et al discloses the apparatus as required of claim 1, wherein the data protection portion includes a file signature checking portion for checking whether the file signature is as expected for media that has not been modified, and wherein a signature check is performed on files as they are installed ['preload sections'; Page 6, paragraph 62; 'game console can detect altered software'; Page 7, paragraph 64].

with regard to claim 15:

Whitten, et al discloses the apparatus as required of claim 1, wherein the data protection portion checks the contents of a file as it is opened ['step 458'; Page 6, paragraph 63].

with regard to claim 16:

Whitten, et al discloses the apparatus as required of claim 1, wherein the file alteration checking portion allows sector level validation rather than file level validation ['step 450'; Page 6, paragraphs 62-63].

with regard to claim 17:

Whitten, et al discloses the apparatus as required of claim 1, wherein the game content is stored in a game console specific format ['portable removable medium', 'portable optical storage media'; Page 3, paragraphs 25, 27].

with regard to claim 18:

Whitten, et al discloses the apparatus as required of claim 1, wherein the media content includes non-game content ['games, music, videos'; Page 3, paragraphs 32-35].

with regard to claim 19:

Whitten, et al discloses the apparatus as required of claim 1, wherein the media content includes non-game content, and wherein the non-game content is stored in a non-game console

specific format ['wma format, digital audio visual'; Page 3, paragraphs 32-35].

with regard to claim 20:

A method comprising: attempting to install a file, wherein the attempting to install the file includes comparing an actual signature of a table of contents from a media with an expected signature of the table of contents; and attempting to read a cluster of data from the media, wherein the attempting to read the cluster of data includes calculating an actual signature, and comparing the actual signature with an expected signature found in the table of contents for every cluster of data read ['steps 434-460', Fig 6; Page 6, paragraphs 56-63].

with regard to claim 21:

Whitten, et al discloses the method as required of claim 20, wherein the file exists on removable media ['CD-ROM, DVD'; Page 3, paragraph 27].

with regard to claim 22:

Whitten, et al discloses the method of game 20, wherein the method is run on a game console ['game console'; Page 1, paragraph 3; 'gaming system, 100'; Page 3, paragraph 27].

with regard to claim 23:

Whitten, et al discloses the method as required of claim 20, wherein the data is stored in a non-game console specific format ['CD, DVD'; Page 3, paragraphs 32-35].

with regard to claim 24:

Whitten, et al discloses the method as required of claim 20, wherein method is a file alteration check ['steps 434-445'; Page 6, paragraphs 56, 57].

with regard to claim 25:

Whitten, et al discloses the method as required of claim 20, that interfaces with a media containing game content [Fig 5; Page 6, paragraph 58].

with regard to claim 26:

Whitten, et al discloses the method as required of claim 20, that interfaces with a media containing non-game content ['authorized media type'; Page 6, paragraph 59].

with regard to claim 27:

Whitten, et al discloses the method as required of claim 20, wherein the data is stored in a game console specific format ['media drive may be capable of reading multiple media types'; Page 5, paragraph 55].

with regard to claim 28:

Whitten, et al discloses a method comprising: obtaining game content from a media; and protecting the game content from modification, using a file alteration checking portion that, by determining whether the game content has been modified, and if the game content has been

modified, then failing to allow the installation of the game content ['computing device is programmed to determine if information in header enables or permits use of digital data'; Page 2, paragraph 12].

with regard to claim 29:

Whitten, et al discloses a computer readable memory having computer readable instructions that when executed by a processor causes the processor to: attempt to install a file, wherein the attempting to install the file includes comparing an actual signature of a table of contents from a media with an expected signature of the table of contents; and attempt to read a cluster of data from the media, wherein the attempting to read the cluster of data includes, for every cluster of data read, calculating an actual signature, and comparing the actual signature with an expected signature found in the table of contents for every cluster of data read ['system for carrying out steps of method used in securing digital data and enforcing secure policy on digital data prior to its use'; Page 2, paragraph 15].

with regard to claim 30:

Whitten, et al discloses a method comprising: attempting to install a file; wherein the attempting to install the file includes: acquiring an expected signature for a table of contents from a media, comparing an actual signature of the table of contents with the expected signature of the table of contents, if the expected signature of the table of contents does not match the actual signature of the table of contents, then failing to install the file, and if the expected signature of the table of contents does match the actual signature of the table of contents, then

installing the file is allowed to continue; and attempting to read a cluster of data from the media, wherein the attempting to read the cluster of data includes: for every cluster of data read, calculating an actual signature, comparing the actual signature with an expected signature found in the table of contents for every cluster of data read, if the actual signature for the cluster of data does not match the expected signature for the cluster of data, then failing to read the clusters of data from the media, and if the actual signature for the cluster of data does match the expected signature for the cluster of data, then reading the clusters of data from the media [‘steps addressed to ensure digital data used by a computing device, such as a game console, is authorized, has not been altered since its release’; Page 2, paragraphs 9-14].

with regard to claim 31:

Whitten, et al discloses a method comprising: locating an expected control data signature from a standard executable; locating control data from a standard executable and computing a computed control data signature in response to the control data; determining whether the computed control data signature matches the expected control data signature; reading expected file data block signatures from the control data; loading a file data block, and computing a computed file data block signature in response to the file data block; and determining whether the computed file data block signature matches the expected file data block signature [‘steps 434-460’; Page 6, paragraphs 56-63].

with regard to claim 32:

Whitten, et al discloses the method as required of claim 31, further comprising failing to install game content in a game console if the computed control data signature does not match the expected control data signature ['if calculated section digest does not match'; Fig 7, Page 6, paragraph 62].

with regard to claim 33:

Whitten, et al discloses the method as required of claim 31, further comprising failing to install game content in a game console if the computed control data signature matches the expected control data signature ['if calculated section digest does not match'; Fig 7, Page 6, paragraph 62].

with regard to claim 34:

Whitten, et al discloses the method as required of claim 31, further comprising launching the game content in a game console if the computed control data signature matches the expected control data signature ['step 462'; Page 7, paragraph 64].

with regard to claim 35:

Whitten, et al discloses the method as required of claim 31, further comprising launching the game content in a game console if the computed file data block signature matches the expected file data block signature ['game console can detect altered software and will not allow any altered software to execute on the console'; Page 7, paragraph 64].

with regard to claim 36:

Whitten, et al discloses a computer readable memory having computer readable instructions that when executed on a processor, causes the processor to protect media associated with game content that can run on a game console from modifying the game content by determining whether the game content has been modified, wherein if the game content has been modified, then the installation of the game content within the game console fails [‘system’; Page 2, paragraph 15; ‘steps 434-460’; Page 6, paragraphs 56-63].

In the broadest sense, a computing device may be any device that includes a processor that executes machine instructions stored in a memory to perform some function. Thus, a computing device can have a dedicated function, or may be very general in functionality, as disclosed by Whitten, et al [Page 1, paragraph 2].

Art Unit: 2136

***Conclusion***

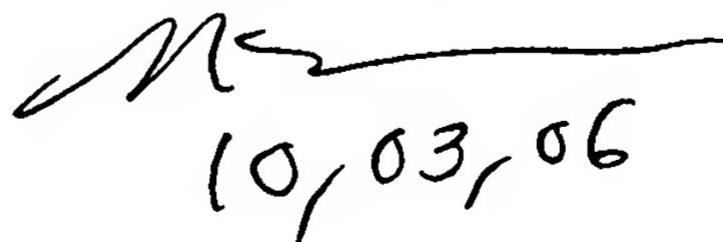
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Russell whose telephone number is 571.272.1095. The examiner can normally be reached on Mon - Fri (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 570.272.4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NASSER MOAZZAMI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

TLR  
20060929

  
10/03/06